

REMARKS

This responds to the Office Action dated September 24, 2007.

Claims 1, 24, 26, 27, 45, 46, 115, 120, 131 and 132 are amended, no claims are canceled, and no claims are added; as a result, claims 1, 2, 4-6, 9-28, 38-48, 56, 63-98, 100-104, 112, 113, 115-120 and 123-150 are now pending in this application.

§112 Rejection of the Claims

Claims 1, 4, 6, 14, 16-20, 24-28, 38-41, 46-48, 56, 63, 65-72, 74-81, 83-87, 89-92, 95, 96, 100-104, 113, 115-117, 120, 123-127 and 131-150 were rejected under 35 U.S.C. § 112, first paragraph, because the specification, while being enabling for inorganic extender pigments, does not reasonably provide enablement for any extender.

Although Applicant believes the specification provides support for a broader class of extenders than “inorganic extenders”, claims 1, 24, 26, 27, 45, 46, 115, 120, 131 and 132 have been amended from describing “extenders” to “inorganic extenders” for the purpose of expediting prosecution of the application. As the Examiner suggested this change, Applicant respectfully requests that the rejection be withdrawn.

§102 Rejection of the Claims

Claims 1, 14, 16, 18-20, 24-26, 28, 63, 67, 70, 71, 96, 102, 115, 116, 120, 125, 134, 139, 141 and 145 were rejected under 35 U.S.C. § 102(b) for anticipation by Boyd et al. (U.S. Patent No. 5,871,839).

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon* 919 F.2d 688, 16 USPQ2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991).

Claim 1 recites: “one or more corrosion-inhibiting carbon pigments.” In contrast, the Boyd reference describes carbon fibers. Thus, the Boyd reference does not teach each element of Claim 1. The fibers of the Boyd reference are not synonymous with the carbon pigments of the present application.

In column 5, lines 54-67 of the Boyd reference, “conductive fiber reinforcement” and “conductive fibers” are defined, and Boyd states “[g]enerally, the conductivity of such fibers

places them in the category of semiconductors.” This description would not lead one skilled in the art to believe the fibers of Boyd are the same as Applicant’s claimed carbon pigments. The definition of a fiber is “a material in a form such that it has a narrow elongated shape (i.e., a minimum ratio of length to average maximum transverse dimension of 10 to 1, a maximum cross-sectional area of $7.85 \times 10^{-5} \text{ in}^2$, corresponding to a circular cross-section of .01 in and a maximum transverse dimension of .010 in.” (ASTM), *see, e.g.,* Paint/Coatings Dictionary, Federation of Societies for Coatings Technology, 1978, p. 177, definition for fiber). Such fibers are unsuitable as a carbon pigment.

In addition to the structural requirements of the fibers disclosed in the reference, Boyd requires that the fibers be conductive. The carbon pigments of Applicant’s invention may be conductive or non-conductive. Tables 8 and 9 of the present application show the application and successful results of using both conductive and non-conductive fibers. This is further evidence that the fibers of Boyd and the pigments of the present invention are not interchangeable.

The Boyd reference uses such defined fibers to construct fiber-reinforced polymer matrixes in which the shape and function of the fibers is necessary to build a “hybrid structure”. For example, in Table 1, the Boyd reference analyzes degradation of a hybrid structure. One of the criteria for evaluation describes the visual description and position of the fibers. As used in the Boyd reference and to one skilled in the art, this definition and use of “fibers” would not include pigments. Pigments are finely divided powders and would not fall into Boyd’s definition of fibers. In fact, the invention described in Boyd would not work if non-fibers were utilized, as the hybrid structure of the corrosible metal and conductive fiber reinforced polymer matrix composite of Boyd relies on the specific shape and function of fibers.

In contrast, a pigment is a finely ground, natural or synthetic, inorganic or organic, insoluble dispersed particles (powder) which, when dispersed in a liquid vehicle to make a coating, provides the essential properties of the coating. *See, e.g.,* Paint/Coatings Dictionary, Federation of Societies for Coatings Technology, 1978, p. 325, definition for pigment. As known to those of skill in the art, pigments come in a variety of sizes, but in general have a rough spherical shape.

A conductive fiber, as taught in Boyd, would not perform as a pigment, and a pigment

would not perform as a fiber, the two are not equivalent. Further, the conductive fiber described in Boyd would not teach, suggest, or motivate one of skill in the art to arrive at Applicant's claimed invention, as carbon fibers and carbon pigments have different properties, shapes, and uses.

Applicant believes the rejected claims to be in allowable condition and respectfully requests withdrawal of the rejection.

§102/§103 Rejection of the Claims

Claims 68, 69, 100, 126, 127 and 147 were rejected under 35 U.S.C. § 102(b) for anticipation by or, in the alternative, under 35 U.S.C. §103(a) as obvious over Boyd et al. (U.S. Patent No. 5,871,839).

Because these claims depend directly or indirectly from Claim 1, which is believed to be allowable, the arguments above are incorporated and Claims 68, 69, 100, 126, 127 and 147 are believed to be allowable condition. Applicant respectfully requests withdrawal of the rejection.

§103 Rejection of the Claims

Claims 17, 27, 113, 117 and 131-133 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Boyd et al. (U.S. Patent No. 5,871,839).

Because these claims depend directly or indirectly from Claim 1, which is believed to be allowable, the arguments above are incorporated and Claims 17, 27, 113, 117 and 131-133 are believed to be allowable condition. Applicant respectfully requests withdrawal of the rejection.

Allowable Subject Matter

Claims 5 and 119 were allowed.

Claim 45 was objected to as being dependent upon a rejected base claim, but was indicated to be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant acknowledges the allowed claims and may choose to rewrite Claim 45 at a future time.

RESERVATION OF RIGHTS

In the interest of clarity and brevity, Applicant may not have addressed every assertion made in the Office Action. Applicant's silence regarding any such assertion does not constitute any admission or acquiescence. Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicant does not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicant timely objects to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicant reserves all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at 612-373-6920 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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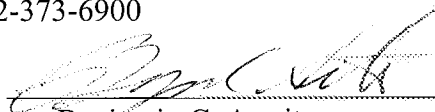
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Date

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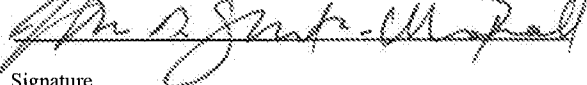
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 21 day of December 2007.

John J. Burke - W. R. R. R.

Name



Signature